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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/519,194 | 12/22/2004 | Nobuaki Yagi | 040894-7146 | 6809 |
| 9629 7590 12/10/2008 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004 | | | | |
| EXAMINER | | | | |
| LOPEZ, MICHELLE | | | | |
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| 3721 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/519,194

Applicant(s)

YAGI ET AL.

Examiner

Michelle Lopez

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This action is in response to the amendment filed on October 14, 2008.
2. Upon further consideration, the indicated allowability of claims 2-5, in the final action mailed on 5/14/08, is hereby withdrawn.
3. Accordingly, the finality of the Office Action mailed on 5/14/08 is hereby also withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of claims 2-5 cannot be clearly understood. i.e. the claims recite a lock mechanism of a table of an electric stapler, yet further claim details of the electric stapler, therefore it is unclear as to whether applicant is claiming a combination of an electric stapler and a lock mechanism, or just the lock mechanism. If applicant is claiming the combination, then the preamble should so state.

Also, in claims 2, 4, and 5, the limitation “wherein a pivoting force in an opening direction of the table” is indefinite in that it is functional and it lacks structure defining the table as to be pivotally supported to the main body frame. Clarification is requested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshie US 6634536 in view of Akizawa et al. US 5009355. Yoshie discloses an electric stapler with a lock mechanism comprising: a magazine portion (600), a staple striking portion (500), a table (210) pivotally supported by a main body frame and including a pivotally clincher mechanism (200), and a wing piece (212) formed on each side of the table (as shown in figs. 48A-48C); locking means formed between each wing piece of the table and the main body frame, wherein a pivoting force in an opening direction of the table is hampered by engaging the locking means with each wing piece of the table (as shown in figs. 70-72). Although Yoshie's locking means comprises a lock plate (251) supported by the main body frame at one end and including a locking pin (32) at the other end (note that "including" doesn't necessarily means that the locking pin (32) needs to be attached to the lock plate), Yoshie fails to disclose wherein the locking pin engages with the wing piece, wherein by engaging the locking pin with the wing piece will hamper the pivoting force in the opening direction of the table is hampered. Akizawa shows an electric stapler having a main body frame (1), a table (4) having a wing piece (including a slot 16) formed on each side of the table (as shown in fig. 2), locking means including a lock plate (6) and a locking pin (17), wherein when the table is moved downwardly to strike a staple by the actuation of a drive shaft (12) and cam member (13), the locking pin (17) engages a lower portion of the wing piece slot (16), thereby, restricting upward movement of the table until further actuation of the drive shaft and cam member occurs. In view of Akizawa, it would have been obvious to one having ordinary skill in the art to have provided Yoshie's locking means with a lock plate and pin as taught by

Akizawa in order to efficiently hamper the pivoting force of the table in an upward and/or opening direction.

With respect to claim 3, Akizawa shows an operating piece 12 and an operating cam 13.

Additionally, the language in claim 3, last paragraph, “wherein, when the operated cam is rotated to separate from the operating piece, by rotating the lock plate by a spring” is functional and afforded light weight because it is predicated on a future act. Furthermore, the functional language is not supported by sufficient structure to perform the rotation of the cam and lock plate.

With respect to claims 4-5, the modified invention of Akizawa fails to disclose wherein the locking means comprises an eccentric cam (claim 4) or locking teeth engageable with engaging teeth, i.e. teeth and rack configuration (claim 5) rather than a locking pin. However, the use of a locking means as an eccentric cam (i.e. a cam member having an engageable projecting portion equivalent to a pin) and a teeth and rack configuration is well known in the art and the Examiner takes official notice that their use is common knowledge in the locks art, for example, for the purpose of providing efficient lock means easy to manufacture and low in cost.

Response to Arguments

6. Applicant's arguments with respect to claims 2-5 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ML/
Patent Examiner

/Rinaldi I Rada/
Supervisory Patent Examiner, Art Unit 3721